

REMARKS

In the Advisory action the examiner stated that the applicant did not have support for reacting at least one monomer of the formula II **which is dissolved in an alcohol as a solvent, with a base**". The applicant respectfully disagrees. Support can be found in example 2.

As the applicant previously stated, this particular selection leads to the benefits as described in the instant specification.

Stern discloses the use a solvent that,

"comprises a compound selected from the group consisting of

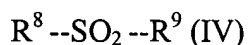
a) amides of the general formula (II)



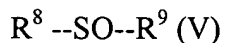
b) amines of the general formula (III)



c) sulfones of the general formula (IV)



d) sulfoxides of the general formula (V)



e) a solvent from the group consisting of alcohols, polyalcohols, glycols and polyethers" (see col. 3, lines 36-55; col. 7, lines 47-67 and col. 10, lines 10-29)

There are five different groups of compounds disclosed for the solvent. The amount of compounds within each group is almost endless. There are 18 examples disclosed in Stern and not one of the examples uses secondary or tertiary alcohol having at least 4 carbon atoms as is

required by the applicant's invention. Not only does the applicant require an alcohol, but the alcohol is secondary or tertiary alcohol having at least 4 carbon atoms (see independent claims 1 and 25).

At least another difference from the instant invention and from the reference cited that the applicant (Stern), is the applicant dissolves formula (II) in the solvent which is an alcohol and not in the form as a base. Claim 26 requires that the alcohol and base are separate components. In the applicant's view, Stern does not disclose, teach nor motivate a person skilled in the art to add the applicant's claimed alcohol as defined by the applicants' process. The Examiner is establishing a hindsight position to make the instant invention obvious.

Even assuming *arguendo*, that one of ordinary skill in the art would react (a) the monomer of the formula II **which is (b) dissolved in an alcohol as a solvent, (c) with a base.** There is no suggestion or teaching that the alcohol is a secondary or tertiary alcohol.

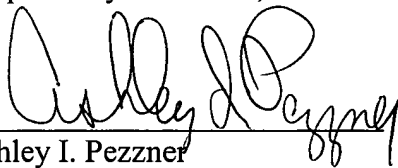
The Examiner must consider the reference as a whole, *In re Yates*, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** (*In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *In re Baird*, 29 USPQ 2d 1550 (CAFC 1994) and *In re Fritch*, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves

must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09931-00016-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 
Ashley I. Pezzner

Registration No.: 35,646
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141
(302) 658-5614 (Fax)
Attorney for Applicant